

REMARKS

The applicant appreciates the Examiner's thorough examination of the application and requests reexamination and reconsideration of the application in view of the following remarks.

The Examiner rejects claims 22-43, 46-47, and 50-71 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,683,610 to *Richards et al.* in view of U.S. Pat. No. 6,016,848 to *Egres Jr.* The Examiner also rejects claims 44-45 as being unpatentable over *Richards et al.* in view of *Egres Jr.* The Examiner further rejects claims 48-49 as being unpatentable over *Richards et al.* in view of *Egres Jr.* as applied to claim 40 and further in view of U.S. Pat. No. 5,598,598 to *Sorenson*.

The applicant's claim 22 recites a foldable member including at least a first tube made of layers of material, and at least one predetermined hinge area along the length of the first tube. A plurality of opposing elongated slots in the tube through the layers of material form separated longitudinal strips of layers of material between the slots which fold when subjected to localized buckling forces.

At least one purpose of the applicant's claimed invention is to provide a foldable (and deployable) member which may be stored when folded, thus saving space.

The applicant's claimed invention is not related to handles or extensions for handles. *Richards et al.* discloses an extension for a handle or similar device. *Richards et al.* teaches and claims a clamp 15 (17, 24 and/or 25), mounted on a clamping area 14 (20 and/or 22) of a tube including strips of material. The clamp compresses the strips of material for gripping a handle telescopically inserted into the tube bore.

Richards et al. never teaches or claims an embodiment without such a clamp; never

teaches the tube strips of material without a clamp to compress them; and never teaches a purpose for the strips of material other than for tighter clamping of the tube material about a handle inserted in the tube.

Importantly also, and in contrast to the applicant's claimed invention, *Richards et al.* fails to teach a hinge area, and *Richards et al.* fails to teach tube material which folds when subjected to localized buckling forces.

The applicant submits that in fact *Richards et al.* teaches away from a hinge area or that the tube material which folds as claimed. In all of the embodiments taught and claimed by *Richards et al.*:

- folding of the tube would destroy the purpose of extending the length of a handle;
- folding the tube would prevent insertion of a handle in the tube bore; and/or
- the clamps would prevent or hinder folding.

It is well established that "teaching away" by one reference is an important *indictum* of non-obviousness. See e.g. W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). The entirety of *Richards et al.* includes disclosures which teach away from the applicant's claimed invention.

At page 311, the Garlock court stated that in considering claims under §103:

... the district court erred... in disregarding disclosures in the references that diverge from and teach away from the invention at hand.

When considered in its entirety, *Richards et al.* includes disclosures which diverge and teach away from the applicant's claimed invention.

Thus, the applicant's claimed invention is non-obvious over *Richards et al.* for at least

these reasons.

With respect to the Examiner's Response to Arguments, the Examiner states that the *Richards et al.* structure "is able to fold when subjected to localized buckling forces as claimed".

As set forth above, the applicant submits that the *Richards et al.* structure – including a tightly compressing clamp and a solid handle inserted in the bore of the tube – would not fold as claimed by the applicant, and the entirety of *Richards et al.* teaches away from the applicant's claimed invention.

The applicant respectfully submits that it is only by hindsight reconstruction that the isolated disclosure in *Richards et al.* of tubes of material was picked and chosen as a basis of rejection of applicant's claims, to the exclusion of the entirety of the teachings of *Richards et al.*. The applicant submits that the longitudinal strips of material disclosed by *Richards et al.* are the only element disclosed by *Richards et al.* discloses which are in any way similar to the applicant's claimed invention, and the hinge area and other features claimed by the applicant are then re-created – in direct contravention to the entirety of the teaching of *Richards et al.* – using hindsight analysis.

The law is clear that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in prior art to deprecate the claimed invention. See e.g. *In re Fine*, 837 F. 2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

Accordingly, the applicant respectfully submits that claim 1 is in condition for allowance and requests that the Examiner withdraw the rejection of claim 1 based on the primary reference *Richards et al.*.

The applicant notes that the secondary cited reference *Egres, Jr.* is cited by the Examiner only for its disclosure of layers of material. The tertiary cited reference *Sorenson* is cited by the

Examiner only for its disclosure of “a second tube disposed inside the first tube”. The applicant submits that neither of these cited references add sufficient disclosure to *Richards et al.* to teach the elements of the applicant’s independent claims which *Richards et al.* is lacking, as discussed above.

Moreover, the extensible handle disclosed by *Sorenson* is incongruous with the clamping handle extension disclosed by *Richards et al.*, and thus these cited references are not properly combinable. *Sorenson* teaches a telescoping handle which consists of two telescoping portions. *Richards et al.* teaches a handle extension into which a handle is inserted and clamped.

In any event, as noted above, the applicant’s claimed invention is not related to handles or extensions for handles.

Independent claims 30, 50, 52, 58, 65, and 67-71 each include at least some variation of the element of longitudinal strips of tube material between slots in the tube. Accordingly, these independent claims, and all claims which depend directly or indirectly from any of them (including dependent claims 23-29, 31-49, 51, 53-57, and 59-64), are also in condition for allowance for at least the same reasons.

CONCLUSION

Each of Examiner’s rejections has been addressed or traversed. Accordingly, it is respectfully submitted that pending claims 22-71 are in condition for allowance. Early and favorable action is respectfully requested.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the

undersigned or his associates, collect in Waltham, Massachusetts at (781) 890-5678.

Respectfully submitted,


Thomas E. Thompkins, Jr.
Reg. No. 47,136